

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number	Filed
		10/764,974	January 26, 2004
		First Named Inventor	
		Gary T. Neel	
		Art Unit	Examiner
		3686	Woods, Teresa S.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>62,926</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Pre-Appeal Brief Request for Review
PATENT
Customer No. 22,852
Attorney Docket No. 06882.0095-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Gary T. NEEL et al.)	Group Art Unit: 3686
)	
Application No.: 10/764,974)	Examiner: Woods, Teresa S.
)	
Filed: January 26, 2004)	Confirmation No.: 9318
)	
For: MEDICAL DIAGNOSTIC TESTING)	VIA EFS WEB
DEVICE WITH VOICE MESSAGE)	
CAPABILITY)	

Mail Stop After Final

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated August 17, 2010 ("Office Action"), Applicants respectfully submit this Pre-Appeal Brief Request for Review, in the above-identified application. This request is being filed with a Notice of Appeal under 37 C.F.R. § 41.31, the required appeal fee, and form PTO/SB/33. Applicants request a Pre-Appeal Brief Conference in accordance with the guidelines set forth in the Official Gazette Notice of July 12, 2005.

REMARKS

Claims 1-30 are pending in the instant application, and all claims stand rejected. Clear error is present in the rejection of claims 1-30, as discussed further below.

I. REJECTION OF CLAIMS 1-24

Claims 1-7 and 12-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/019367 A1 to Ciurczak et al. ("Ciurczak") in view of U.S. Patent No. 6,306,104 to Cunningham et al. ("Cunningham"). Office Action at p. 3. Applicants respectfully traverse. Neither Ciurczak nor Cunningham, alone or in combination, discloses, teaches, or suggests every limitation of claims 1-7 and 12-19.

Independent claim 1 recites, *inter alia*, "recording a voice message, associated with [a] test result, in [a] medical diagnostic test device." Independent claim 12 recites, *inter alia*, "[a] medical diagnostic testing device" that includes "an audio system for recording a voice message associated with [a] test result." Ciurczak and Cunningham, both alone and in combination, fail to disclose, teach, or suggest these limitations.

The Office Action contends that "recording a voice message, associated with [a] test result, in [a] medical diagnostic test device[]" is taught by Ciurczak at paragraph [0101]. *Id.* However, paragraph [0101] of Ciurczak merely suggests a voice recognition program as a "transmission mechanism." In particular, Ciurczak describes using a voice recognition program like a keyboard for inputting and transmitting data to a doctor's central computer. The Office Action has provided no tenable explanation as to how using voice recognition as a "transmission mechanism" is equivalent to recording a voice message. Moreover, even if the use of voice recognition as disclosed in Ciurczak did involve recording, nowhere does Ciurczak disclose, teach, or suggest that such recording would be in a medical diagnostic test device, as opposed to, for example, the doctor's central computer of Ciurczak. Furthermore, like Ciurczak, Cunningham is devoid of any teaching of recording a voice message. Accordingly, it is respectfully submitted that claims 1 and 12 cannot be obvious over Ciurczak in view of Cunningham because they fail to disclose, teach, or suggest all elements claimed.

Consequently, since Ciurczak and Cunningham do not disclose, teach, or suggest every limitation of independent claims 1 and 12, and dependent claims 2-7 and 13-19, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn.

Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciurczak in view of Official Notice. *Id.* at p. 10. Claims 8-11 and 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciurczak in view of U.S. Publication

No. 2005/0002483 A1 to Wilcox (“Wilcox”). *Id.* at p. 13. As discussed above, claims 1 and 12 are not obvious over Ciurczak and Cunningham. Thus, for at least the reasons explained above regarding claims 1 and 12, dependent claims 8-11 and 20-24 are also not obvious over Ciurczak and Cunningham. Furthermore, as discussed further below, Wilcox does not cure the deficiencies of Ciurczak and Cunningham. Therefore, the outstanding rejections manifest clear error, and claims 1-24 should be allowed.

II. MAUS

The Office Action rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Ciurczak in view of Cunningham, but as discussed above, claim 1 is not obvious over Ciurczak in view of Cunningham at least because neither reference teaches “recording a voice message, associated with said test result, in said medical diagnostic test device.” Applicants note that the Office Action, in discussing the elements of claim 1, refers to “Maus” several times. *Id.* at p. 3. Although the Office Action does not clearly identify a Maus reference, it appears the Examiner may be referring to U.S. Patent No. 6,602,469 to Maus et al., which is one of several references included in the Notice of References Cited that was attached to the Office Action of March 16, 2010. This issue was noted in Applicants Reply of June 15, 2010, but was not addressed in the current Office Action. Even though the Office Action does not reject any claims over U.S. Patent No. 6,602,469 to Maus et al. (“Maus”), in the interest of expediting prosecution, Applicants provide the following remarks regarding why the pending claims are patentable over Maus.

Nowhere does Maus teach “recording a voice message, associated with [a] test result, in [a] medical diagnostic test device[,]” as recited in claim 1, or an “audio system” for doing so, as recited in claims 12 and 25. The only audio component included in the diagnostic device of Maus is speaker 35. See Maus at col. 12, ll. 14-26. In particular, Maus explains that a “visual display works in concert with a speaker 35 that beeps to convey audible messages.” *Id.* Maus additionally notes that “[t]he speaker may also produce other types of audible messages, such as tones, recorded messages, a simulated human voice, and the like.” *Id.* (emphasis added). Thus, Maus only teaches an audio element for producing audible messages. While Maus mentions “recorded messages,” this is only as an example of a type of audio the device may be preconfigured to produce

during operation. A speaker configured to play recorded messages is not the same as “an audio system for recording a voice message associated with [a] test result.” Thus, Applicants respectfully submit that claims 1, 12, and 25 would not have been obvious over Maus for at least these reasons.

III. REJECTION OF CLAIMS 25-30

Claims 25, 27, 29, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilcox in view of Cunningham. Office Action at p. 18. Claims 26 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wilcox in view of Official Notice. *Id.* at p. 12. Applicants respectfully traverse these rejections.

Independent claim 25 recites, “In a medical diagnostic testing device that obtains and stores test results, the improvement comprising: an audio system for recording a voice message associated with a test result.” Wilcox and Cunningham, both alone and in combination, fail to disclose, teach, or suggest such a medical diagnostic testing device.

Wilcox merely teaches the use of standard voice recognition software on a computer as a means for a medical professional to input information into a computer. Wilcox is generally directed to methods and apparatuses for outsourcing professional radiology interpretation to ensure high quality service, particularly after normal business hours at the site where the radiology study is obtained. See Wilcox ¶ [0001]. Nowhere does Wilcox specifically disclose an audio system for recording a voice message, let alone such a system incorporated in a medical diagnostic testing device. Wilcox does discuss using voice recognition, but only in disclosing that “[a]fter the interpretation of [a particular radiology] study is completed a formal report is created using industry standard computer based voice recognition software.” Wilcox at ¶ [0009] (emphasis added). Disclosure of using industry standard voice recognition software on a computer is different, on its face, from a medical diagnostic testing device having an audio system for recording a voice message, and the Office Action has provided no tenable argument to the contrary. Thus, Wilcox fails to disclose, teach, or suggest a medical diagnostic testing device that has “an audio system for recording a voice message[,],” as claimed.

The Office Action alleges that “Cunningham discloses... an audio system for recording a voice message associated with a test result (see at least Fig. 1A, column 12,

lines 14-26)." Office Action at p. 18. However, as noted above with respect to claim 12, Cunningham is devoid of any teaching of an audio system for recording a voice message. It appears the Examiner may have been pointing to "Fig. 1A, column 12, lines 14-26" of Maus, as was referenced elsewhere in the Office Action, but nowhere does the Office Action state that claim 25 is rejected as being obvious over Wilcox in view of Maus. Notwithstanding this and in the interest of expediting prosecution, Applicants respectfully submit that claim 25 is not obvious over Wilcox in view of Maus at least because Maus, like Wilcox, fails to disclose, teach, or suggest a medical diagnostic testing device having "an audio system for recording a voice message[.]" as discussed above. Thus, since claim 25 is neither obvious over Wilcox in view of Cunningham, nor obvious over Wilcox in view of Maus, the section 103(a) rejection of claim 25 should be withdrawn.

Furthermore, because claims 26-30 depend from claim 25, it is respectfully submitted that claims 26- 30 are allowable for at least the same reasons as claim 25, and that the section 103(a) rejection of these claims should also be withdrawn.

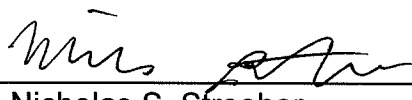
IV. CONCLUSION

In light of the above arguments, Applicants submit that the Examiner failed to show obviousness in rejecting claims 1-30. Therefore, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 9, 2010

By: 
Nicholas S. Stroeher
Reg. No. 62,926
(617) 452-1647